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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/744,784	01/26/2001	Hartmut Breuninger	1998CH017	5014

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CLARIANT CORPORATION
INTELLECTUAL PROPERTY DEPARTMENT
4000 MONROE ROAD
CHARLOTTE, NC 28205

EXAMINER

ELHILO, EISA B

ART UNIT	PAPER NUMBER
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1751

DATE MAILED: 04/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/744,784

Applicant(s)

BREUNINGER ET AL.

Examiner

Eisa B Elhilo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1 This action is responsive to the remarks filed on 1/29/2004.

2 Claims 12-30 and the newly added claim 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kayane et al. (US 4,548,612) in view of Yatake (US 5,560,770), for the reasons set forth in the previous office action in paper 6, dated 10/30/2003.

Response to the applicant's Arguments

3 Applicant's arguments filed 1/29/2004 have been fully considered but they are not persuasive.

With respect to the rejection based upon Kayane (US' 612) in view of Yatake (US' 770), Applicant argues that kayane teaches away from preparing aqueous reactive dye composition comprising urea. The applicant also argues that Kayane et al., teaches the dye compound in the amount of 4.3% by weight. The applicant further argues that the examiner mentioned the thickener as if it were a component (F). The applicant also argues that the wording "consisting essentially of" employed in independent claim 12 excludes the presence of significant amounts of any other components than those defined in the claims, and the wording "consisting of" employed in independent claim 27, also excludes the presence of significant amounts of any other components than those defined in the claim. Furthermore, the applicant argues the compositions described in these two references are of a different kind and have different properties and Kayane does not contain any reason or suggestion for a combination with Yatake that teaches the use of the defined non-clogging inks on recording paper.

The examiner respectfully disagrees with the above arguments because of the following reasons.

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Kayane (US' 612) as primary reference teaches an aqueous dyeing composition (see col. 12, Example 8, lines 67-68). The primary reference also teaches that the aqueous dyeing composition is obtained by dissolving the dyeing ingredients including urea in water (see cols. 17 and 18, Examples 16-20), wherein the thickener is different component in the dyeing composition.

With respect to the percentage amount of the dye ingredient in the composition, the applicant admitted that Kayane et al., teaches about 4.3% of the dye compound in the composition (see remarks, page 8, third paragraph) and not 5% as claimed. The difference between the ranges of the prior art and the claims are close enough to constitute an obviousness rejection. If ranges of the prior art and claimed ranges do not overlap, obviousness rejection may still exist if the range are close enough that one would not expect a difference in properties, while the claimed recites a prima facie case of obviousness exists where the claimed ranges and prior art ranges do not overlap but close enough that one would not expect a difference in properties, *In re Woodruff* 16 USPQ 2d 1034 (Fed. Cir 1990); *Titanium Metals Corp. Corp. V. Banner* 227 USPQ 773 (Fed. Cir. 1985); *In re Aller* 105 USPQ 233 (CCPA 1955). Also, a person of an ordinary skill in the art would optimize the amount of the dye component to obtain the effective amount.

The limitation of the claims under "consisting essentially of" had been made because the prior art of record (US' 612) teaches a reactive dye of halogentriazine and β -sulphatoethylsulphobyl components (see col. 7, formula 2 and col. 8, line 6), which are among the components that claimed within the Markush group in the instant claims. Also the transitional phrase "consisting essentially of" limits the scope of a claim to the specified

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materials or steps “and those that do not materially affect the basic and novel characteristic(s)” of the claimed invention (MPEP 2111.03). Therefore, for search and examination purposes, absent a clear indication in the specification of what the basic and novel characteristics actually are, “consisting essentially of” will be constructed as equivalent to “comprising”. Thus, the examiner believes that the rejection is proper.

With respect to the limitation of claim 27 under “consisting of”. The claim also recites the following phrase “and (F) at least one or more formulating additive”, which is an open ended. Therefore, any formulating additive can be included in the claimed dyeing composition.

With respect to the issue of different references or non-analogous art, The examiner's position is that the references are analogous art because the primary reference of Kayane et al., (US' 612) teaches an aqueous reactive dye composition in which the reactive dyes are the main and essential components in the composition and where in the composition is used for dyeing or printing fiber materials to give dyed or printed product (see abstract). The secondary reference of Yatake (US' 770), teaches an aqueous ink or colorant composition for printing purpose wherein the composition comprising colorants such as reactive dyes (see col. 6, lines 12-19 and col. 7, Examples A1 to A4). Thus, the examiner believes that the references are analogous art.

With respect to the issue of the motivation to combine the references, the examiner's position is that the rejection is proper because the examiner applied the Art of species/genus relationship and is supported by MPEP 2144.08, because the primary reference teaches a composition comprising reactive dyes as the essential components and suggests the use of genus urea as conventional printing assistant component in the composition (see col. 5, lines 3-5). The secondary reference of Yatake teaches a colorant ink composition for printing purposes wherein

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the composition comprising urea/or urea derivatives that include the species of biuret for improving print density (see col. 3, lines 45-50). Therefore, there is a sufficient motivation to use biuret taught by Yatake, in the reactive dyeing composition taught by Kayane with a reasonable expectation of success, because Kayane teaches the use of urea in general for printing assistant and Yatake teaches the advantageous properties associated with biuret component.

4 **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eisa B Elhilo whose telephone number is (571) 272-1315. The examiner can normally be reached on M - F (8:00 -5:30) with alternate Friday off.

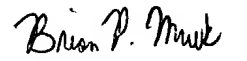
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on (571) 272-1316. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Eisa Elhilo
April 4, 2004



BRIAN P. MRUK
PRIMARY EXAMINER
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